



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,727	05/13/2002	Adam Joshua Wynne	2277.1005000	8257

21005 7590 11/16/2007  
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.  
530 VIRGINIA ROAD  
P.O. BOX 9133  
CONCORD, MA 01742-9133

EXAMINER
----------

LE, KHANH H

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

11/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/030,727

Applicant(s)

WYNNE, ADAM JOSHUA

Examiner

Khanh H. Le

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08/22/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :08/20/2002;  
01/17/2003; 06/09/2004; .

### **DETAILED ACTION**

1. This Office Action is responsive to the response on 08/22/07. Claims 1-16, 19-22 are pending. Claims 2, 4-5, 7-9, 12-13, 15-16 are amended. Claims 17-18 are cancelled. New claims 19-22 are added. Claims 1 and 11 are independent.

#### ***Oath/Declaration***

2. A new oath or declaration is required because the parent application PCT/GB00/02692 was amended on 09/13/2001 and the oath does not reflect this.

The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

#### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hard disk must be shown or the feature(s) canceled from the claim(s). The claimed user computer, the database, the remote site should be labeled. No new matter should be entered.

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show ( i.e. label) the user computer, the database, the remote site, the network channel, as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 10: claimed as dependent of claim 11. This is incorrect. It seems it should depend on claim 9 based on "the encryption process is ..."

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**8. Claims 1-9, 11-16, 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Penkava et al, WO 95 35533 A.**

Independent claims 1 and 11:

PENKAVA discloses a database with information relating to identified computers (page 32 lines 13-17) whereby the information is linked to these computers by their respective unique identifiers (page 16 lines 3-22).

Thus PENKAVA discloses:

A method and system for identifying a computer connected on-line to a remotely located site (e.g. Figures 3-4 item 60 and associated text; page 12 lines 2-4; page 32 lines 13-17) comprising the steps of:

searching a hard disk associated with the computer for an identifying element inherent to the computer (page 14, lines 4-6; e.g. a serial number: page 16 lines 3-22);

combining such an identifying element, when found, together with other identifying information associated with the hardware of the computer, to form a unique identifier for that computer (page 16 lines 3-22: e.g. combining the computer serial number with other computer inherent characteristics);

comparing the unique identifier for the computer ("validation number", see e.g. Figure 4 step 44, which includes the combination of computer inherent characteristics above, Figure 4 step 42) to a store (database: page 32 lines 13-17; see Fig. 6 and associated text) of such unique identifiers available to the remote site;

if the unique identifier is present in the store, accessing data which is available to the remote site and which is associated with that unique identifier (page 30 line 16 to page 32 lines 13-17: e.g. the accessed data is whether user has bought the software or tried it, etc.); and

if the unique identifier is not present in the store, then storing it in the store and recording against it data associated with that computer (these steps are interpreted as building a database of registered identifiable computers on the remote site: page 32 lines 13-17; implicit in PENKAVA).

As to "the data relating, at least partially, to a credit record of previous transactions effected from that computer", PENKAVA does not specifically disclose such.

**However such data is non-functional descriptive material because no steps are performed on the particular data.**

**The Examiner needs not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate.** See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). *In re Gulack*, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability*).

When the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and can not be given any patentable weight. Such a scenario presents

no new and unobvious functional relationship between the descriptive material and the substrate.

In this instance, none of the structure or functionality found in the limitations of claim 1 is due to the information recited. That is the particular information neither enhances nor diminishes the structure and functionality of the underlying database. Here the “structure or functionality” refers to the recited database, computer and remote site and to the storing and accessing of data steps. The pieces of information received into the database are only a compilation of data, that coincides with the definition of non-functional descriptive material in MPEP 2106.

**See also the following USPTO Board of Appeals and Interferences Informative Decisions for similar analyses:**

Ex parte James Prescott Curry,  
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd050509.pdf>

Ex Parte Herman Mathias,  
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>, (affirming a 35 USC section 102 rejection) (also affirmed at the CAFC (August 17, 2006)).

Claims 2 and 12:

PENKAVA discloses a method or system as in claims 1 and 11 above but does not disclose the data associated to that computer, and against which the unique identifier is recorded, relates to further data associated with such previous transactions.

However, as indicated above, as to the independent claims, that data is **non-functional descriptive material**, and is not given patentable weight. In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability*).

Claims 19 and 21:

PENKAVA discloses a method or system as in claims 2 and 12 above but does not disclose said further data comprises credit card details used during such previous transactions.

However, as already indicated above, that data is **non-functional descriptive material**, and is not given patentable weight. In re Gulack, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (*when descriptive material is not functionally related to*

*the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).*

Claims 3-4 and 20, 13-14 and 22:

PENKAVA discloses a method or system as in claims 1 or 2, 11 or 12 above and further discloses the identifying element that is searched for on the hard disk is a predetermined number or type of number, unique to the hardware of the computer, and is a serial number of the hard disk (page 16, lines 3 to 22).

Claim 8:

PENKAVA discloses a method or system as in claims 1 or 2 or 11 or 12 above and further discloses the unique identifier is sent to the remote site, from where it is compared to the store (e.g. Figure 4 item 60; page 12 lines 2-4; page 32 lines 13-17).

Claims 5-6 and 15-16:

PENKAVA discloses a method or system as in claims 1 or 2 or 11 or 12 above and further discloses the other identifying information is information that is associated with the geometry of the hard disk and includes the number of sectors, platters and cylinders in the disk. (page 16, lines 3 to 22).

Claims 7 and 9:

PENKAVA discloses a method as in claims 1 or 2 above and further discloses the combining function is performed on the computer (page 16, line 31 et seq.) and is an encryption process (Figure 2 item 42, page 11 lines 17-18) done to obtain the level of uniqueness or security desired (page 16, lines 15-17).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.



Patentability shall not be negated by the manner in which the invention was made.

**10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over PENKAVA as applied to claim 9 above, and further in view of Official Notice.**

Claim 10:

PENKAVA discloses a method as in claim 9 above and further discloses a checksum encryption and authentication process using the user unique hardware characteristics ( page 16 line 31-page 19 line 23; Figures 6, 16) to ensure correct identification of the user computer (page 19 lines 10-23). However, PENKAVA does not specifically disclose a 'hash-type' encryption and authentication process.

However hash type encryption is a common encryption and authentication method and has been known to be a substitute for checksum encryption and authentication (see e.g. Elliott, US 6468160 B2, col. 33 lines 36-39). Thus, it would have been obvious to a Phosita to substitute such hash type method to PENKAVA's checksum as an alternate encryption encryption and authentication method, to achieve the desired and predictable result of properly securing data.

### ***Conclusion***

**II.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Elliott, US 6468160 B2 and progeny disclose security system for video game system with hard disk drive and internet access capability using hash encryption.

Ginter et al, US 5892900 A and progeny disclose systems and methods for secure transaction management and electronic rights protection.

Fielder US 5995624 A discloses bilateral authentication and information encryption token system and method.

Blakley III et al US 5677952 A discloses method to protect information on a computer storage device using hash encryption.

Pace US 5689561 A and US 6061656 disclose computer-based trading card system and method using hash encryption.

Chow US 2002/0002678 discloses internet authentication technology.

Crawford US 6411943 discloses secured internet credit/debit card transactions.

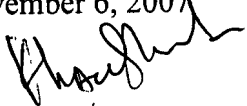
Logan, US 5199066 A discloses method and apparatus for protecting software.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

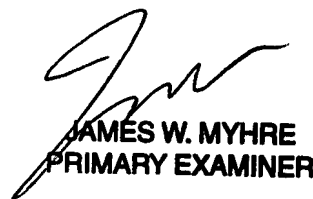
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 6, 2007



KHL



JAMES W. MYHRE  
PRIMARY EXAMINER